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| 09/158,728 | 09/22/1998 | STEVEN CRAIG WEIRATHER | 67134-5021 | 4296 |

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/158,728

Applicant(s)

WEIRATHER ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 479-482, 486-489, 491-499, 501-504, 506, 508-527 and 529-537 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 479-482, 486-489, 491-499, 501-504, 506, 508-527 and 529-537 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/20/06, 6/12/06, 5/12/06, 2/5/06</u> | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

Request for Continued Examination

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on June 12, 2006 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 479-482, 486-489, 491-499, 501-504, 506, 508-527 and 529-537 are pending in the application, claims 1-478, 483-485, 490, 500, 505, 507 and 528 have been cancelled.
3. Amendments to the claims, filed on June 12, 2006, have been entered in the above-identified application.

REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

5. Claims 479-482, 483-489, 491-499, 501-504, 506, 508-514, 524-529 and 532-537 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross (U.S. Patent No. 4,863,772) in view of Popat et al. (U.S. Patent No. 5,407,718).

Cross discloses a label stock with a dry separation interface, used as tags, coupons identification cards and the like (*col. 1, lines 7-9*) that may then be used in a computerized printing of names and addresses on dry labels or cards by the printer of a PC computer (*col. 4, lines 51-53*).

Regarding Applicant's claim 479, Cross discloses a printable business card sheet (*label stock, title*) comprising a dry laminate sheet construction including a facestock sheet construction (*label construction, col. 5, line 23*) and a continuous carrier sheet (*liner proper, col. 5, line 14*) attached to a back side of the facestock sheet construction (*figure 5*). The facestock sheet construction may also includes through-cut lines (*die-cutting, col. 4, lines 45-46*). The facestock construction including a face sheet, a film layer, and an adhesive layer between the facestock sheet and the film liner (*figure 5*).

The dry laminate sheet construction is deemed to be sized, constructed and adapted to be sheet-fed through a printer or copier for a printing operation on the printable business cards, since the reference discloses that the label stock may then be used for computerized printing on dry label or cards by the printer of a PC computer (*col. 4, lines 51-53*).

The top surface of the facestock sheet construction is deemed to be constructed and adapted to receive indicia printed on the top surface during the printing operation (*col. 4, lines 51-53*).

The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet after the printing operation into individual printed business cards whose back side surfaces are non-tacky, since the reference discloses that the labels will be picked-off individually by the user (*col. 4, lines 47-48*) and that the dry labels of the invention have no tack when individually handled (*col. 1, lines 9-10*).

The preamble/limitation "business card" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In

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article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, lines 3-7 and page 3, line 25 through page 4, line 9*). Cross’ labels are deemed to meet this limitation because Cross’ labels are also the cut out portion of the printable material.

Cross fails to disclose that the facestock continuous through-cut lines pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet and that the through-cut lines are deemed to define at least in part perimeter edges of printable business cards and a matrix waste portion around the printable business cards or areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation.

Popat teaches label sheets used for printing with personal computers (*col. 1, lines 12-19*). The label sheets comprise a sheet construction that comprises a label layer, i.e. facestock sheet construction, and an adhesive layer, and backing layer (*col. 2, lines 64-68*), which acts as a release liner (*col. 3, lines 18-19*), i.e. carrier sheet.

Popat’s label comprises facestock continuous through-cut lines (*die cut lines, col. 3, line 15*) that pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet (*col. 3, lines 15-21*) and that the through-cut lines are deemed to define at least in part perimeter edges of printable business cards and a matrix waste portion around the printable business cards (*figure 1*).

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Areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation (*figure 2 and col. 3, lines 15-21*).

The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet and from the matrix waste portion after the printing operation into individual printed business cards (*figure 1 and col. 3, lines 15-21*).

The die cuts also help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*col. 3, lines 1-4*).

Cross and Popat are analogous because they are both discuss label sheets used for printing with personal computers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the die cut arrangement of the through-cut lines with the cuts only going through the facestock construction and not the carrier sheet of Popat as the die cuttings of Cross in order to help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*Popat col. 3, lines 1-4*). Furthermore, it would have been an obvious matter of design choice to change the configuration of the through-cut lines, since a modification would have involved a mere change in size of the label. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

It is desirable to use Popat's through-cut lines configuration in order to maximize the number of labels per sheet.

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Regarding Applicant's claims 480-482, 486, 487, 491-494, 498, 499, 502, 503, 514, 529 and 531-534, figures 1 and 2 in Popat shows:

That the printable business cards form a block of printable business cards and the matrix waste portion forms a frame around the block.

That the carrier sheet is a solid continuous carrier sheet and covers all of the back sides of all the through-cut lines.

The carrier sheet is a solid continuous carrier sheet which extends the entire width of the facestock sheet construction

Adjacent ones of the printable business cards directly abut one another.

The printable business cards are arranged in a grid on the facestock sheet construction.

The facestock sheet construction includes left and right side edges and first and second end edges, the through-cut lines include frame cut lines and grid cut lines, the frame cut lines include first and second side cut lines spaced in from the left and right side edges respectively, and disposed parallel thereto, and first and second end cut lines spaced in from and parallel to the first and second end edges, both of the end cut lines engaging both of the side cut lines, the frame cut lines defining a central area on the facestock sheet construction, the grid cut lines defining a central area, and the grid cut lines and the frame cut lines separating the central area into the printable business cards.

That some of the grid lines extend across and outwardly of the first and second side cut lines.

That the through-cut lines include vertical and horizontal cut lines.

That a top one of the horizontal cut lines extends a full width of the facestock sheet construction.

The ends of the rest of the horizontal cut lines are space inwardly from the left and right side edges of the facestock sheet construction.

The rest of the horizontal cut lines extend a distance out beyond the outermost of the vertical cut lines.

The carrier sheet covers the entire back side of the facestock sheet construction.

The through-cut lines define all of the perimeter edges of all the printable business cards.

The printable business cards are arranged in a two column matrix on the facestock sheet construction.

The printable business cards in each column of the two column matrix abut adjacent printable business cards in the same column separated only by respective ones of the through-cut lines.

The facestock sheet construction and the carrier sheet are both rectangular and have the same width and length dimensions.

The areas of the carrier sheet cover the back sides of all the through-cut lines.

Regarding Applicant's claim 536, Cross discloses the facestock sheet construction includes a facestock sheet (*facestock proper*, col. 4, lines 30-31) and an adhesive layer (*adhesive*, col. 4, line 32).

Regarding Applicant's claims 488, 495-497 and 504, Cross discloses that the carrier sheet comprises includes a base paper sheet of densified bleached kraft sheet, since the reference discloses the liner proper is a base paper sheet such as densified bleached kraft sheet (col. 5, lines

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32-34). The liner proper is 3.1 mil thick (*col. 5, line 32*), which is deemed to be *approximately* 3.0 mil and *approximately* 2.0 mil.

Regarding Applicant's claims 489, 537 and 535, Cross discloses that the facestock sheet construction and dry laminate sheet construction includes a polyethylene layer (*col. 5, lines 13-16 and figure 5*).

Regarding Applicant's claims 500 and 501, Cross discloses that the facestock sheet construction includes a facestock sheet (*facestock proper, col. 4, line 44*) and dry laminate sheet construction includes a polyethylene layer (*col. 5, lines 13-16 and figure 5*) between the facestock sheet and the carrier sheet which includes a paper sheet (*liner proper of kraft paper, col. 5, line 14 and 32-34*).

Regarding Applicant's claim 505-513, Cross discloses the facestock sheet construction includes a facestock/cardstock sheet (*facestock proper, col. 4, lines 30-31*) and an adhesive layer (*adhesive, col. 4, line 32*) and a film layer (*polyethylene layer, col. 5, lines 13-16 and figure 5*). The film layer is low-density polyethylene film (*col. 5, line 6*) and carrier sheet is a densified bleached kraft liner sheet (*col. 5, line 14 and 32-34*).

It is noted that Cross does not disclose the adhesive being a hot melt adhesive or claimed thickness of the layers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a hot melt adhesive for the adhesive for the dry release film layer, since it would have been within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, unless hot melts adhesives give unexpected results. *In re Leshin*, 125 USPQ 416.

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Furthermore, the exact thickness of the layers is deemed to be a result effective variable with regard to size of paper acceptable for sending through a printer. It would require routine experimentation to determine the optimum value of a result effective variable, such as combined thickness of layers, in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used with.

Regarding Applicant's claim 524, Cross discloses the carrier sheet is secured directly to the back side of the face stock sheet construction and a back side of the carrier sheet defines a back surface of the printable business card sheet (*figure 5*).

Regarding Applicant's claims 525-527, Cross fails to disclose that the dry laminate sheet construction is 8.5 by 11 inches, 8.5 by 14 inches or has A4 width and length dimensions.

Popat discloses that the label sheet may be a standard 8.5 by 11 inch sheet or other dimensions such as sheets with smaller dimensions, legal size or various other sizes which allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (*col. 5, lines 1-11*).

Therefore, it would have been an obvious matter of design choice to change the size of sheet construction, since a modification would have involved a mere change in size. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

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One of ordinary skill in the art would have been motivated to change the size of the sheet construction in order to allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (*Popat col. 5, lines 1-11*).

Regarding Applicant's claim 528, Cross discloses that portions of the facestock sheet construction form back side surfaces of the printable business cards (*figure 5*).

6. Claims 515 and 516 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross in view of Popat as applied above, and further in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Cross and Popat are relied upon as described above.

Cross and Popat fail to disclose an infeed edge of the printable business card sheet, along an entire width of the sheet is thinner than a body of the sheet or a lead-in edge of the printable business card sheet is calendared.

Examiner's comment: The limitation "the lead-in edge of the printable business card sheet is calendared" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendared end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the lead-in edge of the printable business card sheet is calendared," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the

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front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

Cross, Popat and Hickenbotham are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet suggested by the combination of Cross and Popat above, as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing.

One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at *col. 1, lines 38-51*.

It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

7. Claims 517-523 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross in view of Popat as applied above, and further in view of Klein (U.S. Patent No. 5,198,275).

Cross and Popat are relied upon as described above.

Cross and Popat fail to disclose that the carrier sheet includes a flexibility line that is a cut line.

Klein discloses a card stock sheet for labels (*col. 3, line 13*) comprising a lift out panel with rectangular score cuts, an adhesive, and a backing sheet with perforations (*figure 6*). The backing sheet with perforations corresponds to Applicant's carrier sheet with flexibility/cut lines.

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The perforations ensure a smooth peripheral edge of each panel and smoothness of the edge at the panel face is enhanced without any roughness or frying or torn paper (*col. 3, lines 62-66*).

Cross, Popat and Klein are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Klein's perforations to the web suggested by the combination of Popat and Cross in order to facilitate easy removal of the web. One of ordinary skill in the art would have been motivated to use Klein's perforations as taught in *col. 3, lines 62-66*, where Klein teaches that the perforations ensure a smooth peripheral edge without any roughness of frying or torn paper.

The exact distance of the liner sheet cut lines to the end of the sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as distance of liner sheet cut line to the end of the sheet through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

8. Claims 530 and 531 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross in view of Popat as applied above, and further in view of Carlson (U.S. Patent No. 5,842,722).

Cross and Popat are relied upon as described above.

Cross and Popat fail to disclose that the facestock sheet construction comprises a top coating that forms a top receptive surface of each of the printable business cards.

Carlson discloses a printable laminate useful in forming die-cut identification cards, labels, etc. (*col. 1, lines 16-18*). The printable laminate includes die cut cards, which are coated

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with an ink receptive coating (*col. 19, line 50 through col. 20, line 3*). The ink receptive coating provides good ink image retention and adhesive retention (*col. 20, lines 1-3*).

Cross, Popat and Carlson are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Carlson's ink receptive coating to the facestock sheet construction suggested by the combination of Cross and Popat in order to enhance the adhesion of the ink to the label. One of ordinary skill in the art would have been motivated to employ Carlson's ink receptive coating because of the improved image retention and adhesive retention of the ink (*col. 20, lines 1-3*). It is desirable to enhance the adhesion of the ink to the label so that the ink would not rub off after being applied to the label.

ANSWERS TO APPLICANT'S ARGUMENTS

9. Applicant's arguments in response filed June 12, 2006 regarding the 35 U.S.C. 103 over Cross in view of Popat of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Cross uses a different printing process, i.e. they strip off the matrix before printing.

First, the method of using the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. Second, Applicant has not provided any evidence that Cross is not "capable" of structurally holding the printable business cards and the matrix waste portion together during a different printing operation. In

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conclusion, the fact remains that the combination of Cross and Popat disclose all of Applicant claimed structure.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
8/20/06

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